

REMARKS

Claims 1 to 12 are pending. The Examiner has issued a restriction requirement between Group I (claims 1-11) and Group II (claim 12) as apparatus and process for its practice under MPEP 806.05(c).

Applicants provisionally elect Group I with traverse.

MPEP § 803 recognizes two separate requirements that an Examiner must show to make a proper restriction requirement:

1. The inventions must be independent or distinct as claimed; and
2. There would be a serious burden to the Examiner the application unless restriction is imposed.

In all restriction requirements, the distinctiveness requirement is governed by MPEP § 806 and the burden requirement by MPEP § 808.02. These are two separate requirements that must both be satisfied in order to establish a *prima facie* basis for restriction. “Where the related inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required.” MPEP § 808.2 (emphasis added). Where the burden requirement is not met for a restriction, then that restriction requirement is improper.

First, in a restriction of this type (apparatus and process for its practice), the Examiner must demonstrate that either the process as claimed can be practiced by another materially different apparatus or by hand, or that the apparatus as claimed can be used to practice another and materially different process. The claims of Group I are method claims, directed generally toward dynamically allocating a device to a bus. The

single claim in Group II, claim 12, is directed toward a computer bus management system which also associates a bus to a device.

The Examiner is required to show how the process of Group I can be practiced by another materially different apparatus. The Examiner has not shown a materially different apparatus for practicing the process of Group I. Instead, the Examiner has stated that the process can be use for “configuring network devices”. This is a different use of the claimed process, not a materially different apparatus from claim 12. Further, even if the Examiner meant to say that “network device” could perform the method, this is simply too general of a statement: There is no explanation whatsoever of what kind of “network device” the Examiner is referring to, how it could perform the method of claim 1, and how it would be materially different from the apparatus of claim 12. Accordingly, the Examiner has failed to establish a prima facie basis of distinctiveness.

Second, the Examiner has not provided any explanation of why a serious burden would be imposed on the Examiner for restriction between Groups I and II. While the groups are said to be in different subclasses of the same general class, that alone does not demonstrate a serious burden to search. Specifically, Group I is classified in Class 710, subclass 305, while Group II is classified in Class 710, subclass 316. However, subclass 316 is itself a subclass of subclass 305. According to MPEP 904.02(a), in conducting a classified search, “a proper field of search normally includes the subclass in which the claimed subject matter of an application would be properly classified....The field of search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.” Thus, the Examiner is already instructed to

consider subclass 316 when searching class 305 for Group I. Thus there is no serious burden on the Examiner to do what the MPEP specifically instructs him to do. Further, the Examiner is also required by the MPEP to search “analogous arts”: “Not only must the art be searched within which the invention claimed is classifiable, but also all analogous arts must be searched regardless of where the claimed invention is classified.” (MPEP 904.01(c)). Clearly, subclass 316, being a subclass of 305 is nothing if not “analogous art,” and again would have to be searched in any event. Thus, there is no question that the Examiner would already be searching both subclasses 305 and 316 in order to thoroughly cover all art that relates to the subject matter of Group I. Accordingly, there is no serious additional burden on the Examiner. Thus, the restriction requirement is improper on its face.

Therefore, the Examiner is asked to withdraw the restriction requirement and to issue an office action on the merits.

If any matters remain outstanding prior to allowance of the claims, the Examiner is invited to contact the undersigned attorney at (415) 875-2358 or via e-mail at dbrownstone@fenwick.com. Applicants acknowledge that a copy of any electronic mail communications will be made of record in the application file per MPEP § 502.03.

Respectfully submitted,
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